UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,675	12/17/2003	Akira Yoda	3562-0133P	4112

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EXAMINER
KUCAB, JAMIE R

ART UNIT	PAPER NUMBER
3621	

NOTIFICATION DATE	DELIVERY MODE
09/04/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _21 May 2008_.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-18_ is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) _1-18_ is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
        1.☐ Certified copies of the priority documents have been received.
        2.☐ Certified copies of the priority documents have been received in Application No. _____.
        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 C.F.R. § 1.114

1.   A request for continued examination ("RCE") under 37 C.F.R. §1.114, including

the fee set forth in 37 C.F.R. § 1.17(e), was filed in this application after final rejection.

Since this application is eligible for continued examination under 37 C.F.R. § 1.114, and

the fee set forth in 37 C.F.R. § 1.17(e) has been timely paid, the finality of the previous

Office action has been withdrawn pursuant to 37 C.F.R. § 1.114. Applicant's

submission filed on May 21, 2008 has been entered.

Acknowledgements

2.   In accordance with the RCE above, claims 1-18 are currently pending.

3.   This Office action is given Paper No. 20080826 for reference purposes only.

4.   Based on a comparison of the PGPub US 2004/0139333 A1 with Applicant's

originally submitted specification, the PGPub appears to be a fair and accurate record of

the Applicant's specification. Therefore, if necessary any references in this action to

Applicant's specification refer to paragraph numbers in the PGPub.

Claim Rejections - 35 USC § 101

5.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

6.   Claims 1-18 are rejected under 35 U.S.C. §101, because the claimed invention is

directed to non-statutory subject matter.

7.   Claims 1 and 12 recite in the preamble "An authentication processing and
information storing apparatus" The body of claim 1 recites various "sections" in each
limitation, including "a personal information storing section," "an accessible person
information storing section," "an access level setting section," etc. Claims 1 and 12 are
considered non-statutory because the sections are considered to be software, per se.
Functional Descriptive material per se is not statutory. Functional Descriptive material
in combination with an appropriate computer readable medium must be capable of
producing a useful, concrete and tangible result when used in a computer system.
Since the "sections" lack storage on a medium and there are no instructions in
executable form, no underlying functionality occurs and thus there is no practical
application. For these reasons, claims 1 and 12 fail to satisfy one of the statutory
categories set forth in 35 U.S.C. 101 and are therefore considered to be non-statutory.
Claims 2-11 are dependent from claim 1 and stand rejected under the same reasoning.

8.   Claims 13-18 recite a process of authenticating a requester of personal
information comprising the steps of storing personal information, storing accessor
characteristic information, receiving requester information, etc. Based on Supreme
Court precedent, a § 101 process must be tied to another statutory class or transform
underlying subject matter to a different state or thing (*Diamond v. Diehr,* 450 U.S. 175,
184 (1981); *Parker* v. *Flook,* 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson,* 409
U.S. *63,* 70 (1972); *Cochrane* v. *Deener,* 94 U.S. 780,787-88 (1876)). Since neither of
these requirements is met by the claim, the method is not considered a patent-eligible
process under 35 U.S.C. 101. To qualify as a statutory process, the claim should

positively recite the other statutory class to which it is tied, for example by identifying the

apparatus that accomplished the method steps or positively reciting the subject matter

that is being transformed, for example by identifying the material that is being changed

to a different state.

Claim Rejections - 35 USC § 103

9.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

10.   Claims 1, 7, 9, 10, 11, and 13 are rejected under 35 U.S.C. §103(a) as being

unpatentable over Deindl et al. (6,031,910, hereinafter "Deindl") in view of Houvener et.

al. (6,070,141, hereinafter "Houvener").

11.   Regarding claims 1 and 13, Deindl discloses an authentication processing and

information storing apparatus ("patient card") performing requester authentication

processing and storing thereon an owner's personal information (C2 L25 - C8 L10),

comprising:

- a personal information storing section (file 100) storing thereon the owner's

     (patient's) personal information (data record 120) which is to be disclosed to a

     plurality of predetermined accessible persons ("a plurality of users", C2 L25-32),

     wherein at least one of the plurality of predetermined accessible persons is

     someone other than the owner (C2 L25 - C8 L10);

- an access level setting section ("management fields") setting an access level, which is a level of the personal information to be disclosed to the requester, when said requester authentication section authenticates the requester as the accessible person (C3 L36-54); and

- a personal information output section (READ/WRITE DEVICE 340 in Fig. 3) outputting a part of the personal information stored on said personal information storing section to the requester in accordance with the access level set-up by said access level setting section (C4 L37 - C6 L19).

12.   Although Deindl discloses a requester authentication section ("authorization card", C6 L33-43; user card 310 in Fig. 3 and associated text) and characteristic information ("a surety", C6 L33-43; "identification feature", C6 L57- C7 L6) that may be biometric (C6 L33-43), Deindl fails to explicitly disclose:

- an accessible person information storing section storing thereon accessible person characteristic information indicating a physical characteristic of each of the plurality of accessible persons;

- a requester authentication section receiving requester characteristic information indicating a physical characteristic of a requester who requests the personal information, and for performing authentication processing of the requester using the requester characteristic information and the accessible person characteristic information stored on said accessible person information storing section.

13.   However, Houvener teaches:

- an accessible person information storing section ("valid user database", col. 10 line 40) storing thereon accessible person characteristic information ("first and second ID units", col. 3 lines 55-56) indicating a physical characteristic ("retinal image", col. 9 line 20) of each of the plurality of accessible persons;

- a requester authentication section (point of identification terminal 1 in Fig. 1) receiving requester characteristic information indicating a physical characteristic of a requester who requests the personal information, and for performing authentication processing of the requester using the requester characteristic information and the accessible person characteristic information stored on said accessible person information storing section (Fig. 6A and 6B and associated text).

14.   It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the apparatus of Deindl to include the accessible person information storing section and requester authentication section of Houvener in order to achieve the predictable result of providing a secure and robust means of biometric authentication.

15.   Regarding claim 7, Houvener further discloses wherein said accessible person information storing section stores a plurality of accessible person characteristic information of each of the accessible persons ("first and second ID units", col. 3 lines 55-56), said requester authentication section receives a plurality of requester characteristic information (steps 220 and 245 in Fig. 6A), and performs authentication

processing of the requester using the plurality of accessible person characteristic

information and the plurality of requester characteristic information (step 260 in Fig. 6B).

16.   Regarding claim 9, Houvener further discloses wherein said requester

authentication section employs face information ("retinal image", col. 9 line 20) as the

requester characteristic information and the accessible person characteristic

information.

17.   Regarding claim 10, Houvener further discloses the apparatus further comprising

an image capturing section ("automated comparison system", col. 9 lines17-18) for

generating the requester characteristic information by capturing an image of the

requester.

18.   Regarding claim 11, Houvener further discloses wherein said requester

authentication section receives the requester characteristic information from a portable

apparatus retained by the requester ("smart card", col. 10 line 29), and said personal

information output section outputs the personal information to the portable apparatus

retained by the requester and causes the portable apparatus to store the personal

information (col. 10 lines 29-30).

19.   Claims 2-6, 12, and 14-18 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Deindl in view of Houvener and further in view of Schneider et al.

(6,105,027).

20.   Regarding claims 2, 3, 14, and 15, Deindl/Houvener disclose the claimed

invention, however, Deindl/Houvener fail to explicitly disclose the apparatus further

comprising an access level storing section storing thereon a personal information level,

which is a level of the personal information to be disclosed to the accessible person,

and an authentication criterion, which is strictness of the authentication to be performed

when the personal information within the personal information level is disclosed, in

association with each other, wherein said access level setting section determines the

personal information level corresponding to the authentication criterion as at least a part

of the access level when said requester authentication section authenticates the

requester by the authentication criterion. Schneider et al. teach an access level storing

section (Fig. 6) storing thereon a personal information level ("Trust/Data Sensitivity

Level" in Fig. 6), which is a level of the personal information to be disclosed to the

accessible person, and an authentication criterion ("Minimum Encryption" in Fig. 6),

which is strictness of the authentication to be performed when the personal information

within the personal information level is disclosed, in association with each other,

wherein said access level setting section determines the personal information level

corresponding to the authentication criterion as at least a part of the access level when

said requester authentication section authenticates the requester by the authentication

criterion (col. 18 lines 6-11). It would have been obvious to one having ordinary skill in

the art at the time of the invention to modify the apparatus of Deindl/Houvener to include

the access level storing section of Schneider et al. in order to provide different levels of

access to different users.

21.   Regarding claims 4, 5, 16, and 17, Deindl/Houvener disclose the claimed

invention, however, Deindl/Houvener fail to explicitly disclose wherein said access level

storing section stores the plurality of personal information levels and also stores a lower

limit of credibility of the authentication as the authentication criterion corresponding to

each of the personal information levels, said requester authentication section outputs

the credibility of the authentication for the requester based on the result of the

comparison of the requester characteristic information with the accessible person

characteristic information, and said access level setting section selects the personal

information level of which the lower limit of the corresponding credibility is less than the

credibility of the authentication output by said requester authentication section, and sets

the access level to the sum of the selected personal information levels. Schneider et al.

disclose an access level storing section that stores the plurality of personal information

levels ("Trust/Data Sensitivity Level" in Fig. 6) and also stores a lower limit of credibility

of the authentication as the authentication criterion corresponding to each of the

personal information levels ("Minimum Authentication" in Fig. 6), said requester

authentication section outputs the credibility of the authentication for the requester

based on the result of the comparison of the requester characteristic information with

the accessible person characteristic information (col. 19 line 55 - col. 20 line 11), and

said access level setting section selects the personal information level of which the

lower limit of the corresponding credibility is less than the credibility of the authentication

output by said requester authentication section, and sets the access level to the sum of

the selected personal information levels (col. 19 line 55 - col. 20 line 11). It would have

been obvious to one having ordinary skill in the art at the time of the invention to modify

the apparatus of Deindl/Houvener to include the access level storing section of

Schneider et al. in order to provide different levels of access to different users.

22.   Regarding claims 6, 12, and 18, Deindl/Houvener disclose the claimed invention,

but Deindl/Houvener fail to explicitly disclose the apparatus further comprising wherein

said access level storing section stores the personal information level and the

authentication criterion in association with a title of the requester, said requester

authentication section further receives the title of the requester from a belonging of the

requester, and performs authentication processing of the requester using the

authentication criterion by reading the authentication criterion corresponding to the

received title from said access level storing section, and said access level setting

section sets the access level to the personal information level corresponding to the title

of the requester when said requester authentication section authenticates the requester

as the accessible person. Schneider et al. teach an access level storing section

(access filter 203 in Fig. 2) that stores the personal information level and the

authentication criterion in association with a title of the requester ("UserGroupID" in Fig.

13A), said requester authentication section further receives the title of the requester

from a belonging of the requester ("SmartCard" in Fig. 13A), and performs

authentication processing of the requester using the authentication criterion by reading

the authentication criterion corresponding to the received title from said access level

storing section, and said access level setting section sets the access level to the

personal information level corresponding to the title of the requester when said

requester authentication section authenticates the requester as the accessible person

(col. 35 lines 4-23). It would have been obvious to one having ordinary skill in the art at

the time of the invention to modify the apparatus of Deindl/Houvener to include the

access level storing section of Schneider et al. in order to more efficiently provide

information access to groups of users.

23.   Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable Deindl in view

of Houvener and further in view of Examiner's Official Notice. Deindl/Houvener disclose

the claimed invention, but Deindl/Houvener fail to explicitly disclose that the information

storing apparatus is retained by the owner. However, the Examiner takes Official Notice

that it is old and well known in the art to make an information storing apparatus portable

such that it can be retained by the owner, because this allows individuals to eliminate

redundant objects by transporting them from one location to another. It would have

been obvious to a person having ordinary skill in the art at the time of invention to make

the information storing apparatus portable such that it can be retained by the owner in

order to achieve the predictable result of providing the owner of information with control

over the security of that information.

Examiner Note

24.   The Examiner has cited particular columns and line numbers in the references as

applied to the claims above for the convenience of the Applicant. Although the specified

citations are representative of the teachings in the art and are applied to the specific

limitations within the individual claim, other passages and figures may be applied as

well. It is respectfully requested from the Applicant, in preparing responses, to fully

consider the reference in its entirety as potentially teaching all or part of the claimed

invention as well as the context of the passage as taught by the prior art or disclosed by

the Examiner.

Claim Interpretation

25.   Except where expressly noted otherwise, the Examiner maintains the claim

interpretations and definitions of paragraphs 26-30 of the previous Office action (Paper

No. 20080116) mailed January 29, 2008.

Response to Arguments

26.   Applicant's arguments with respect to the objections to claim 1 have been fully

considered and are persuasive. The objections to claim 1 have been withdrawn.

27.   Applicant's arguments with respect to the restriction requirement have been fully

considered and are persuasive. The restriction requirement of the previous Office

action has been withdrawn.

28.   Applicant's arguments with respect to the 102 and 103 rejection of the claims

have been considered but are moot in view of the new grounds of rejection.

Conclusion

29.   Any inquiry concerning this communication or earlier communications from the

Examiner should be directed to Jamie Kucab whose telephone number is 571-270-

3025. The Examiner can normally be reached on Monday-Friday 9:30am-6:00pm EST.

30.   If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's

supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

31.   Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JK

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